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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,905	02/14/2001	Kiyoko Karusawa	14318	3208
23389	7590	05/04/2004	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC			YUN, EUGENE	
400 GARDEN CITY PLAZA			ART UNIT	PAPER NUMBER
GARDEN CITY, NY 11530			2682	9

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/782,905	KARUSAWA, KIYOKO
	Examiner Eugene Yun	Art Unit 2682

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 February 2001 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borland (WO 99/26394) in view of Morita (JP 10-42036).

Referring to Claim 1, Borland teaches a telephone with an originator acknowledge function, comprising:

an originator confirmation button and response button 130 (fig. 3);  
response mode control means 200 (fig. 3) for controlling a response mode to an originator confirmation mode in which only reception is possible when said originator confirmation button is operated, and controlling the response mode to a normal response mode in which both transmission and reception are possible when said response button is operated (see pg. 3, lines 6-14);

display means for displaying a calling number received in terminating operation (see pg. 3, lines 4-5);

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channel control means for activating said response mode control means and connecting a channel in the originator confirmation mode in accordance with an operation of said originator confirmation button in terminating operation (see pg. 7, lines 11-17);

message sending means for sending a first message prompting a response of an originator to the channel when the channel is connected in the originator confirmation mode (see pg. 7, lines 27-32); and

monitor means for outputting a speech signal of the originator from the channel to a recipient via a receiver after the first message is sent (see ABSTRACT),

wherein said response mode control means switches the response mode from the originator confirmation mode to the normal response mode when said response button is operated during the originator confirmation mode (see ABSTRACT).

Borland does not teach the telephone being a portable telephone. Morita teaches the telephone being a portable telephone (see ABSTRACT). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Morita to said device of Borland in order to better prevent malicious calls from reaching a mobile subscriber.

Referring to Claim 2, Borland also teaches timer means for measuring a predetermined time after the first message is sent, and said channel control means disconnecting the channel when said timer means measures the predetermined time (see pg. 15, lines 5-18).

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Referring to Claim 3, Borland also teaches timer means for measuring a predetermined time after the originator confirmation mode starts, and said channel control means disconnecting the channel when said timer means measures the predetermined time (see pg. 15, lines 5-18).

Referring to Claim 4, Borland also teaches a channel disconnection button and the channel forcibly disconnected immediately after said message sending means sends a second message representing rejection of a response when said channel disconnection button is operated during the originator confirmation mode (see pg. 18, lines 1-5).

Referring to Claim 5, Borland also teaches a calling number registration memory for registering a calling number in advance, said channel control means connecting the channel in the originator confirmation mode a predetermined time after terminating operation when a calling number received in terminating operation is not registered in said calling number registration memory, and said message sending means sending the first message to the channel after the channel is connected (see pg. 9, lines 15-28).

Referring to Claim 6, Borland also teaches transmitter and receiver for transmitting and receiving speech to and from the originator via the channel, and said response mode control means enabling only said receiver in the originator confirmation mode, and enabling both said transmitter and receiver in the normal response mode (see ABSTRACT).

Referring to Claim 7, Borland also teaches said monitor means outputting the first message sent to the channel from said receiver to the recipient 810 (fig. 12).

Referring to Claim 8, Borland teaches a telephone with an originator acknowledge function, comprising:

- an originator confirmation button for confirming an originator 130 (fig. 3);
- a response button for setting a normal speech communication state 130 (fig. 3);
- display means for displaying a calling number received in terminating operation (see pg. 3, lines 4-5);
- channel control means for activating said response mode control means and connecting a channel in the originator confirmation mode in accordance with an operation of said originator confirmation button in terminating operation (see pg. 7, lines 11-17);
- message sending means for sending a first message prompting a response of an originator to the channel when the channel is connected in the originator confirmation mode (see pg. 7, lines 27-32);
- monitor means for sending a speech signal received via the channel to a receiver for a predetermined time and performing monitor operation after the message is sent (see ABSTRACT); and
- transmission/reception means for setting a speech communication state in accordance with an operation of said response button during monitor operation (see ABSTRACT).

Borland does not teach the telephone being a portable telephone. Morita teaches the telephone being a portable telephone (see ABSTRACT). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide

the teachings of Morita to said device of Borland in order to better prevent malicious calls from reaching a mobile subscriber.

***Response to Arguments***

4. Applicant's arguments filed 2/19/2004 have been fully considered but they are not persuasive.

Regarding Claim 1, the applicant argues that the Borland reference does not teach channel control means for activating said response mode control means and connecting a channel in the originator confirmation mode in accordance with an operation of said originator confirmation button in terminating operation. The examiner does not see a unique function in this limitation as this limitation simply describes operation of the automatic response through the communications channel when a call is received from an outside source while the "no-call" feature is enabled, which the above cited passage in the Borland clearly teaches. In fact, this aspect of the claim can be read on to suggest automatically receiving a voice mail greeting when a call is made to a cellular phone which is turned off, a feature well known in the art.

Regarding Claim 8, the same remarks above apply to the applicant's arguments regarding this claim.

Regarding Claim 2, five rings can be considered a predetermined time as there is no further detail in the claim to suggest otherwise.

Regarding Claim 4, putting the telephone on-hook immediately after taking the telephone off-hook can be described as a channel disconnect button as there is no further detail in the claim to suggest otherwise.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (703) 305-2689. The examiner can normally be reached on 8:30am-5:30pm Alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EY  
Eugene Yun  
Examiner  
Art Unit 2682

EY

  
VIVIAN CHIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600